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EXAMINER

NEWHOUSE, NATHAN JEFFREY

ART UNIT	PAPER NUMBER
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3727

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Please find below and/or attached an Office communication concerning this application or proceeding.

Application/Control Number: 09/701,057

Art Unit: 3727



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 15

Application Number: 09/701,057

Filing Date: November 22, 2000

Appellant(s): VON SPRECKEISEN ET AL.

Francis A. Sirm
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

This is in response to the appeal brief filed June 18, 2003, the reply brief of Oct. 14, 2003 and the remand to the examiner of May 19, 2005.

Application/Control Number: 09/701,057

Art Unit: 3727

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 12-16 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

Application/Control Number: 09/701,057

Art Unit: 3727

4,815,618	GACH	3-1989
6,117,506	GRABOSKI et al.	9-2000
6,082,568	FLANAGAN	7-2000
6,076,334	KITAHORA et al.	6-2000
4,141,680	KAUFFMAN et al.	2-1979

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gach '618 in view of Graboski et al. '506. Gach teaches a molded bottle 10, a cap and neck assembly 18 and a foil 56 located between them. The cap and neck assembly is heat sealed to the bottleneck 14 after the bottle has been filled. See col. 3, lines 28-47. With respect to the cap and neck assembly being "injection moulded", it has been held that method limitations in a product claim do not serve to patentably distinguish the claimed product from the prior art. See *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). Thus, even though a product-by-process claim is limited and defined by a process, determination of patentability is based on the product itself. Accordingly, if the product in a product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process. *Thorpe*, 777 F.2d at 697, 227 USPQ at 966; *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983). Gach does not teach the bottle being made by extrusion blow molding to form a thin walled bottle and being non-gas tight. Graboski et al. teaches a bottle that is made by extrusion blow molding. See column 2, lines 59-64.

Application/Control Number: 09/701,057

Art Unit: 3727

The resulting bottle has a thickness of 0.381mm(0.015 in.) to 2.159mm(0.085 in.) and can be made of high-density polyethylene, which is the same material as applicant's invention and is non-gas tight. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the bottle of Gach by extrusion blow molding to form a "thin walled" bottle made of high density polyethylene as taught by Graboski et al. to provide a bottle which protects its contents from degradation from light.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gach '618 in view of Graboski et al. '506, as applied to claim 11 above, and further in view of Flanagan '568. Gach, as modified above, does not teach the method of forming the method of forming the cap and neck assembly by injection molding. Flanagan teaches a similar cap and neck assembly to what is taught by Gach. Flanagan further teaches that this cap and neck assembly is made by injection molding. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the cap and neck assembly of Gach by injection molding as taught by Flanagan, as this is a well known method of making caps.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gach '618 in view of Graboski et al. '506 and Flanagan '568 as applied to claim 12 above, and further in view of Kitahora et al '334. Gach, as modified above, teaches everything except for the foil being sterilized before applying to the bottle. Kitahora et al. teaches a method of forming and closing a bottle. A perform is extrusion blow molded to form a bottle, the bottle is then filled, and the bottle is closed by a cap assembly with the cap

Application/Control Number: 09/701,057

Art Unit: 3727

assembly being sterilized prior to applying. It would have been obvious to one of ordinary skill in the art at the time the invention was made to sterilize the cap and neck assembly of Gach as taught by Kitahora et al., prior to applying the cap and neck assembly to the bottle, to remove any dirt, etc. from the cap to prevent contamination of the product in the bottle.

Claims 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gach '618 in view of Graboski et al. '506 and Flanagan '568 as applied to claim 12 above, and further in view of Kauffman et al. '680. Gach, as modified above, teaches the bottle being made by extrusion blow molding, but does not teach the bottle being formed by rotary machine. Kauffman et al. teaches bottles that are formed by a rotary extrusion blow molding method and apparatus. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the bottle of Gach by a rotary extrusion blow molding as taught by Kauffman et al. as this is a well known method extrusion blow molding of bottles.

(11) Response to Argument

With respect to appellant's argument that appellant's invention solves a long felt need of mating a resealable injection-molded cap to an extrusion-blow-molded thin-walled bottle, appellant submits exhibits A-F to support this assertion. The exhibits (A-F) are articles which generally state that appellant's closure is "revolutionary" and previous closures leaked. First, appellant has not met the burden of establishing a long felt need. See MPEP 716.04. Appellant has not shown that an art recognized problem existed in the art for a long period of time without solution. *In re Gershon*, 372 F.2d 535,

Application/Control Number: 09/701,057

Art Unit: 3727

539, 152 USPQ 602, 605 (CCPA 1967). There is no support within these articles that a long felt need existed or that others in the art unsuccessfully attempted to solve the problem. Second, appellant has not shown that the long felt need must not have been satisfied by another before the invention by applicant. *Newell Companies V. Kenney Mfg. Co.*, 864 F.2d 757, 768, 9 USPQ2d 1417, 1426 (Fed. Cir. 1988). The mere fact that prior milk containers leaked does not support the requirement that others in the art unsuccessfully attempted to solve this problem. Appellant's invention solved the "mismatch" between the injection molded cap and the extrusion blow molded bottle which caused the leak known in the milk bottle industry. However, the U.S. Patent 4,722,448 to Nolan teaches an injection molded cap used to seal a blow molded milk bottle as the cap is attached to the bottle via a foil seal which is heat sealed to the bottle. In response to appellant's arguments concerning the Nolan reference, it should first be pointed out that cap of Nolan is attached to the bottle neck by a snap as characterized by appellant. However, the cap of Nolan in figure 9 employs a foil seal that is heat sealed to the bottle neck. The cap is therefore attached to the bottle neck by a heat seal, as the cap is attached to the foil via a backing layer that is adhesively attached to the cap irrespective of the cap being attached to the bottle neck by a snap. Appellant further argues differences between Nolan and appellant's invention, but these points are moot as Nolan was not applied against appellant's invention. Nolan was merely cited as showing that it was known that an injection molded cap can be heat sealed to a blow molded bottle and therefore the long felt need of mating a resealable injection molded cap to a blow molded bottle was not solved by appellant's invention.

Application/Control Number: 09/701,057

Art Unit: 3727

The further characterization of the cap and bottle arrangement of Nolan being "unreliable" as the bond between the foil and the backing layer is broken during initial opening with the backing layer remaining attached to the cap to be used as a seal upon reclosing is not pertinent.

With respect to appellant's exhibits G and H, the fact that appellant's invention was patented in Great Britain and Australia has no bearing on the patentability of appellant's invention in the United States.

With respect to appellant's exhibit I (introduced for the first time in the reply brief filed Oct. 14, 2003), appellant argues that the first three pages describe problems in the packaging of milk in blow molded plastic containers resealed by injection molded caps. Appellant further states that page 4, line 36 through page 5, line 21 appellant's invention is described as a solution to this problem. Appellant then states that the applicant (Portola Packaging) of the publication of Exhibit I supplies 60% of the closures in the U.K. and over 50% of the closures in the U.S. Apparently this leads to the conclusion that appellant solves the long felt need of an injection molded cap reliable mating with blow molded plastic containers. This argument is not found persuasive. First, the publication in exhibit I, states that "in recent years a large number of different designs of cap" have been proposed to address the problems of leakage between injection molded caps and blow molded bottles. (page 3, lines 15-18). The publication then gives examples, including a plug seal on the cap to engage the rim of the container, or the cap being sealed to the bottle via a foil liner that is heat sealed (appellant's invention). As the publication gives two different designs of solving the long felt need of an injection

Application/Control Number: 09/701,057

Art Unit: 3727

molded cap mating with a blow molded bottle, it is not clear how appellant believes that only their invention solves this long felt need when there are other designs that also solve this problem. As such the evidence in this publication does not support appellant's conclusion that their invention solved the long felt need of an injection molded cap reliably mating with a blow molded bottle. Moreover, the publication points out numerous problems with appellant's invention, such as, this design is incapable of accommodating the chimney associated with ram-down neck finishes, and the increase in cost associated with the use of the foil liner.

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine these references was set forth in the rejections. See section 10 of the examiner's answer.

In response to appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does


Application/Control Number: 09/701,057

Art Unit: 3727

not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Clearly, Gach teaches a resealable neck and cap assembly that is applied to a plastic bottle. Gach teaches the use of a foil seal to ensure that no leakage occurs between the cap and neck assembly and the plastic bottle. Graboski et al. teaches a well known method of making an extrusion blow molded bottle. Flanagan teaches a well known method of making an injection molded cap and neck assembly. Using these well known methods to form the plastic bottle and cap and neck assembly of Gach is within the general knowledge of one of ordinary skill in the art.

For the above reasons, it is believed that the rejections should be sustained.

Application/Control Number: 09/701,057
Art Unit: 3727

Respectfully submitted,

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Primary Examiner
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June 22, 2005

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